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09/478,051	01/15/2000	MICHAEL J. PICCIALLO	P-22425-B-US	1136

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EXAMINER

KUCAB, JAMIE R

ART UNIT	PAPER NUMBER
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3621

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08/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/478,051	Applicant(s) PICCIALLO, MICHAEL J.	
	Examiner JAMIE KUCAB	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/24/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 75,77-85,87,98,99,101-108 and 110 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75,77-85,87,98,99,101-108 and 110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Applicant's response filed 03/24/2009 is acknowledged.
2. Claims 75, 77-85, 87, 98, 99, 101-108, and 110 are pending in the application. Claims 75, 77-85, 87, 98, 99, 101-108, and 110 are examined below.
3. This Office action is given Paper No. 20090807 for reference purposes only.

Priority

4. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. §119(e) or under 35 U.S.C. §§ 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §120 as follows:
 5. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. §112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).
 6. The disclosure of the prior-filed application, Application No. 08/585173, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. 08/585173 fails to provide

the necessary support for such limitations as “entered by said fund depositor with a personal computer”, “supplying to said fund depositor through a CRT output device...”, and “wherein said fund depositor account and said third party account communicate through an external bank, credit card or atm network” of claim 75, nor does the prior-filed application provide support for similar limitations in the remaining independent claims (88 and 99).

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 98 is rejected under 35 U.S.C. §101, because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). The process steps in claim 98 are not tied to another statutory class nor do they execute a transformation. Thus, it is non-statutory.

Claim Rejections - 35 USC § 112 1st Paragraph

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 75, 77-85, 87, 99, 101-108, and 110 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Although Applicant discloses an “external bank, credit card or atm network”, neither the original specification nor claims disclose that the fund depositor account and the third party account communicate with each other through such a network.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 75, 77-85, 87, 99, 101-108, and 110 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano et al., U.S. Patent No. 5,845,260 in view of Anderson et al., U.S. Patent No. 5,706,442 and Dorrough et al., U.S. Patent No. 5,287,269.

13. As per claims 75, 77-85, 87, 99, 101-108, and 110, Nakano et al. teach a computer based method for transferring funds to a third party comprising:

a. using information entered by a depositor on a PC to create a third party account (figures 2 and 6)

b. periodic (e.g. weekly, monthly) and automatic transfer of funds into the third party account (column 6, lines 47-57)

c. [periodically] limiting the funds spent and how funds are spent (abstract; column 6, lines 47-57; column 7, lines 15-25 and 43-50; column 8, lines 4-9)

14. Regarding how information is sent to the credit card company by a user/parent, Nakano et al. teach managing the third party account over telephone, cable or other communications network (column 6, lines 40-46), hence the use of a computer is inherent, at least suggested by Nakano et al. or an obvious modification as it is not invention to merely automate a known manual activity that produces the same result (In re Venner, 120 USPQ 192 (CCPA 1958); In re Rundell, 9 USPQ 220 (CCPA 1931)).

15. As per claims 78, 80, and 99, it is inherent that a bank or other financial institution will verify that there are sufficient funds in an account in order support a funds transfer, for example. Nakano et al. disclose storing information on fund transferees and payment amounts for said third party account (figures 2 and 6; column 4, lines 42-53; column 6, lines 11-28) however, Nakano et al. do explicitly recite a depositor viewing said information. Anderson et al. teach presenting account activity and balances to a user at CRT or LCD device (column/line 1/55-2/8) over the internet (column/line 1/55-2/8) and multiple accounts communicating over an external network (Abstract, Fig. 1 and associated text). It would have been obvious to combine the viewing and networking capabilities of Anderson with the method of Nakano, as the claimed steps

were known in the prior art and one skilled in the art could have combined the steps as claimed with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

16. As per claims 84 and 108, it has been taken as admitted prior art that a well known method for exchanging data over the internet is via electronic mail (see Office action mailed 09/06/2007).

17. However, neither Nakano et al. nor Anderson et al. specifically recite issuing an encoded card to a second user (e.g. a child). Dorrough et al. teach issuing a magnetic card to a child ('269, column/line 1/65-2/22; column 6, lines 47-65) and encoding the magnetic card with account information ('269, column 6, lines 47-65; column 7, lines 6-16 and 27-34; column 9, lines 3-20), it would have been obvious to one of ordinary skill to combine the teachings of Nakano et al., Anderson et al. and Dorrough et al. in order allow a child to play games both online and offline and control how much the child spends on the games ('269, column 7, lines 35-68; column 11, lines 27-68; '260, abstract; column 6, lines 47-57; column 7, lines 15-25 and 43-50; column 8, lines 4-9). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Nakano et al. and Anderson et al. in order to enable depositors to efficiently keep track her/his finances ('442, column/line 1/22-2/7).

Response to Arguments

18. Applicant's arguments filed 03/24/2009 have been fully considered, but they are only partially persuasive.

19. Applicant's cancellation of claims 88 and 90-96 renders the §101 rejections of these claims moot. Therefore, the §101 rejections of claims 88 and 90-96 are hereby withdrawn. Applicant's intention to cancel claim 98 is noted. The §101 rejection of claim 98 will be withdrawn when this claim is cancelled.

20. Applicant's arguments regarding the §112, 1st paragraph rejection of claims 75, 77-85, 87, 99, 101-108, and 110 have been fully considered, but they are not persuasive. Applicant argues the fund depositor account and the third party account communicating through an "external bank, credit card or atm network" is disclosed at page 16, lines 3-5, page 20, last paragraph, and page 20, lines 15-19. The Examiner must respectfully disagree. In these portions of the specification, Applicant discloses an "external bank, credit card or atm network," but none of the cited portions of the specification provide support for the fund depositor account and the third party account communicating with each other through such a network.

21. In response to Applicant's argument that Nakano fails to disclose "...wherein said fund depositor account and said third party account communicate through an external bank, credit card or atm network," the Examiner must respectfully disagree. First, a recitation of the intended use of the claimed invention must result in additional steps between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art method is capable of performing the intended use, then it meets the claim. Second, as noted by Applicant, Nakano discloses that the parent is later billed on their credit card for the purchases made by the child. In order to do this, it is necessary for network communication to occur

between the cable operator and the credit card company. Therefore, Nakano discloses such communication.

Conclusion

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

24. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

25. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted).

26. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

27. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621